

REMARKS

Claims 1-9, 11-13, 15-25, and 27- 29 are currently pending in the subject application and are presently under consideration. Claims 1, 11, 19, 21, and 27 have been amended as shown on pp. 7-11 of the Reply. In addition, the specification has been amended as indicated on pp. 3-6. Claim 10, 14, 26, and 30 are cancelled.

Applicants' representative thanks Examiner Verdi for the courtesies extended during the telephonic interview conducted on October 17, 2007. The Examiner was contacted to discuss proposed amendments to overcome the rejections under 35 U.S.C. § 101, 102, 103, and 112, and interpretation of the cited prior art references with respect to limitations of independent and dependent claims. Partial agreement was reached regarding moving toward patentable subject matter.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection to the Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 760, Figure 7. The reference 760 is added to the specification by this amendment and this objection should be withdrawn.

II. Rejection of Claims 26 and 30 Under 35 U.S.C. §101

Claims 26 and 30 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 26 and 30 are cancelled, and this rejection should be withdrawn.

III. Rejection of Claims 1-9, 19-20, 22, and 24-26 Under 35 U.S.C. §103(a)

Claims 1-9, 19-20, 22, and 24-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2001/0044904 A1 to Berg *et al.* (hereinafter Berg) in view of United States Patent 5,390,301 to Scherf. This rejection should be withdrawn for at least the following reasons. Berg and Scherf, alone

or in combination do not teach or suggest each and every element as set forth in the subject claims.

A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Federal Circuit has held that teaching away from the art of the subject invention is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

The subject claims generally relate to a shimming system that implements and supports driver unique context information. More particularly, the system comprises a shim engine component that receives a notification signal indicating when a driver is loaded. Upon receipt of the signal the shim engine can query a shim database to determine if any shim components or shim packages are associated with the loaded driver. Thereafter, the shim engine can load any associated shim components and generate or load a context component associated with the loaded driver. Additionally, the shimming system can include a diagnostic component that monitors a system and, upon a system crash or a detected instability or inefficiency, queries the shim database to determine if a shim component is available that if applied would fix or compensate for the problem causing the crash, instability or inefficiency. (See specification first paragraph page 4.)

Toward this end, claim 1 (and similarly claims 11, 19, 21, and 27) recites *a system for kernel-mode shimming comprising: a plurality of driver components; a common shim component that provides added functionality to the plurality of driver components; a context component associated with each driver component that retrieves and maintains driver context information; and a diagnostic component that can engage in a probabilistic analysis based on the cost of making an incorrect diagnosis and/or selecting the wrong shim weighed against the benefit of correction.* Berg and Scherf alone or in combination fail to teach or suggest such claimed aspects. Berg merely describes a method of providing secure communication with kernel-level components of a computer system having an operating system that includes user space and kernel space.

The method includes the step of locating an authentication module in the kernel space, in communicably coupled relation with the kernel-level components, to selectively encrypt and decrypt communications between the kernel-level components and a remote site. The method also includes locating a transport module in the kernel space, in communicably coupled relation with the authentication module, to selectively transmit and receive the communications. (See Berg paragraph 6.)

Scherf merely describes there is provided a standardized method of communication between a device driver and a system kernel which addresses problems. The driver characterizes the device abilities in a uniform manner and the kernel can access the relevant information efficiently. The method facilitates the communication of numeric limitations as well as flags. It keys information by both major and minor numbers, thus allowing access to individual device information even when several devices share a driver. Finally, by providing an extendible data structure, the method allows for addition of new types of information without the sacrifices required by standardization. (See Scherf first summary paragraph.) Notably Berg and Scherf do not describe the functionality of *a diagnostic component that can engage in a probabilistic analysis based on the cost of making an incorrect diagnosis and/or selecting the wrong shim weighed against the benefit of correction.*

IV. Rejection of Claim 10 Under 35 U.S.C. §103(a)

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2001/0044904 A1 to Berg in view of United States Patent 5,390,301 to Scherf as applied to claim 1 above, and further in view of “Exploiting Software Interfaces for Performance Measurement” by Konkin *et al.* (hereinafter Konkin). This rejection should be withdrawn for at least the following reasons. Berg, Scherf, and Konkin, alone or in combination do not teach or suggest each and every element as set forth in the subject claims. Konkin does not cure the defects of Berg and Scherf. Konkin merely describes software interfaces for performance measurement. (See Konkin title and page 216 lines 41-50.) However, Berg, Scherf, and Konkin do not describe the functionality of *a diagnostic component that can engage in a*

probabilistic analysis based on the cost of making an incorrect diagnosis and/or selecting the wrong shim weighed against the benefit of correction.

V. Rejection of Claims 11-13, 21, 23, and 27-30 Under 35 U.S.C. §103(a)

Claims 11-13, 21, 23, and 27-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 5,390,301 to Scherf in view of United States Patent Application Publication 2001/0044904 A1 to Berg. See section III above for reasons why this rejection should be withdrawn.

VI. Rejection of Claims 14-18 Under 35 U.S.C. §103(a)

Claims 1-9, 19-20, 22, and 24-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent 5,390,301 to Scherf in view of United States Patent Application Publication 2001/0044904 A1 to Berg as applied to claim 11 above, and further in view of “Exploiting Software Interfaces for Performance Measurement” by Konkin. See section IV above for reasons why this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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